

REMARKS

The Office Action dated March 9, 2005 has been received and carefully considered. In response, Applicant has provided a Terminal Disclaimer, terminally disclaiming any term which extends beyond U.S. Patent No. 6,745,899. However, Applicant respectfully submits that the combination of Nagata No. JP 58-183570 and Smith et al. GB 2 332 451 is improper and, further, does not show the limitations of the claims of this application. Accordingly, reconsideration and allowance is respectfully requested.

Claims 48-53 were rejected under 35 U.S.C. §103(a) as being unpatentable over Nagata in view of Smith.

In rejecting claims under 35 U.S.C. §103 "the Examiner bears the initial burden of presenting a prima facie case of obviousness." *In re Oetiker*, 977 F2d 1443 (CAFC 1992). Only if that burden is met, does the burden of coming forward with evidence or arguments shift to Applicant. *Id.*

A prima facie case of obviousness requires that there be some teaching, reason, suggestion or motivation found in the prior art references whereby it would have been obvious to a person of ordinary skill to make the particular selection in combination by the patentee. *In re Belle*, 991 F2d 781 (CAFC 1993); *in re Gorman*, 933 F2d 982 (CAFC 1991); *in re Chow*, 813 F2d 378 (CAFC 1987).

The teaching, reason, suggestion or motivation cannot come from Applicant's invention or application itself. (See *Diversitech Corp. v. Century Steps, Inc.* 850 F2d 675) (CAFC 1988)); *in re Geiger*, 815 F2d 686 (CAFC 1987)).

The mere fact that the prior art may be modified to support a finding of obviousness does not, in itself, make the application obvious unless the prior art suggested the desirability of the modification. (*In re Gorman.*) Hindsight reconstruction of the prior art is impermissible to support a finding of obviousness, and it is impermissible to use the claimed invention as an instruction manual or a template to piece together the teachings of the prior art. *Id.*

There is no teaching, reason, suggestion or motivation to combine Nagata with Smith. As an initial matter, Nagata is a Japanese patent, and the record does not include a translation. Accordingly, at most the Examining Attorney can be relying upon the drawings

of Nagata for the rejection of this application. (MPEP § 706.02.) As such, the following language from §106 of the MPEP applies:

If the document is in a language other than English and the Examiner seeks to rely on that document, a translation must be obtained so that the record is clear as to the precise facts the Examiner is relying upon in support of the rejection. The record must also be clear as to whether the Examiner is relying upon the Abstract or the full text document to support a rejection. (MPEP § 706.02).

The drawings of Nagata do not show the claimed invention, and it is likely that the specification in Nagata supports the same. In this respect, as is shown in the drawings of Nagata, Nagata discloses only a two-ring arrangement wherein the rings are positioned side-by-side one another and rest directly on the coil top. Nagata fails to disclose, or in any way suggest or make obvious, utilizing a third ring positioned over top of his two rings. The Examiner acknowledges that Nagata fails to disclose a third ring. Smith fails to overcome the shortcomings of Nagata, because it also does not show a third ring. Further, Smith fails to show even a second ring or remotely suggest using the Smith ring with any other ring. In fact, Smith teaches of the advantages of its smooth underside surface that directs the outgoing welding wire up its tapered ring configuration. (Page 3, last paragraph.) The ring in Smith is also placed directly on the coil top. Again, Nagata discloses a two-ring arrangement wherein both rings are placed directly on the coil top. Smith discloses a single ring arrangement wherein its single ring is placed directly on the coil top. In order to reject the claims of this application based on the Examiner's argument, there must be some suggestion or motivation in these references to stack these rings on one another. That suggestion or motivation does not exist in these references in that both disclose the advantages of using their specific ring design. Smith goes into great detail on how his ring provides tangle-free wire control by its unified structure that both engages the sidewalls of the welding drum and includes a smooth, cone-shaped underside surface. To say that there is a motivation to position a flat, annular ring, below the cone-shape of the Smith

design is not supported by the record. Stacking the Smith ring on the Nagata ring is not suggested in the art, and there is not motivation to combine. Applicant respectfully submits that the Examiner must disclose this motivation and has failed to do so.

Independent claim 48 patentably distinguishes from Nagata in view of Smith. In this respect, claim 48 recites a payout device which includes a first, second and a third ring. As is discussed above, neither Nagata nor Smith disclose a three-ring structure. Further, there is no suggestion or motivation in these references to make this blind combination of stacking the Smith ring over top of the Nagata ring. Again, with reference to page 3 of the Smith patent, the last paragraph, Smith touts the advantage of his smooth underside wherein the wire unwinds smoothly with no snagging. The inclusion of flat, annular rings, underneath Smith's smooth cone shape, would either prevent the wire from following the smooth, curved shape of the Smith ring, or have no function at all. Again, Applicant respectfully submits that there is no suggestion or motivation in these references for the combination of stacking these rings on one another to create Applicant's third ring.

Claim 48 further patentably distinguishes from the cited references by reciting the third ring overlaying the first and second rings and at least partially covering the gap between the first and second rings. Applicant respectfully submits that in addition to above, there is no disclosure in the cited references for the recited partial covering. Only the improper use of hindsight reconstruction could create a combination of Nagata and Smith to precisely size Smith to partially cover the gap of Nagata. There is no suggestion or motivation in the art to re-size Smith to partially cover the gap of Nagata.

In summary, Applicant respectfully submits there is no suggestion or motivation to stack these distinctly different rings from the cited references on one another in an attempt to achieve the recited ring structure of this application. Only the improper use of hindsight reconstruction could achieve such a result. As the Examiner has acknowledged, Nagata fails to disclose a third ring. Smith also fails to disclose a third ring. Smith only discloses a first ring. Accordingly, Applicant respectfully submits that claim 48 patentably distinguishes from the cited references and is allowable.

Claims 49-50 are dependent from independent claim 48 and are patentable for at least the same reasons.

Claim 52 patentably distinguishes from the cited references by reciting a second ring which overlies the first ring. Both Nagata and Smith fail to disclose one ring positioned over top of another ring. As is discussed above in greater detail, stacking the rings of Smith and Nagata would defeat the discussed advantages of each ring. Further, there is no motivation or suggestion in these references to make such a combination. Only the improper use of hindsight consideration, in view of Applicant's disclosure, could create such a combination.

Claim 53 patentably distinguishes from the cited references for at least the same reasons as claim 48 discussed above in greater detail. In this respect, claim 53 also recites a third ring which works in connection with a first and a second ring to control the payout for unwinding of the wire from the welding wire coil. Nagata and Smith or in combination fail to disclose a three-ring structure. Further, such a combination is not suggested in the references and, therefore, the combination is improper. Accordingly, claim 53 patentably distinguishes from the cited references and is allowable.

The above-identified Office Action further includes descriptions concerning the cited references and the claims of this application. While Applicant agrees that Nagata fails to disclose or make obvious a third ring, Applicant does not acquiesce to these comments made concerning the claims of this application. Again, Applicant respectfully submits that the cited references fail to disclose the recited ring structure. Accordingly, these claims are deemed to be in allowable form, whereby reconsideration is respectfully requested.

Enclosed herewith is a Terminal Disclaimer terminally disclaiming the above-identified patent application with respect to Patent No. 6,745,899.

Claims 48-51 and 53 were rejected under the judicially created doctrine of obviousness – type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,745,899. As is stated above, Applicant has provided the requested Terminal Disclaimer. Accordingly, Applicant respectfully submits that these claims are in allowable form, whereby reconsideration and allowance is respectfully requested. This rejection also includes statements concerning the claim language of this application. Applicant does not agree or acquiesce to all the statements made by the Examiner.

Applicant respectfully submits that claims 48-53 patentably distinguish from the prior art and are in allowable form.

Applicant respectfully submits that each issue raised in the above-identified Office Action has been addressed by this response. Accordingly, reconsideration of the claims is respectfully requested.

5/5/05
Date

Respectfully submitted,

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